

REMARKS

Claims 15-29 are pending. Applicants cancel claims 1-14 and 30-62 without prejudice or disclaimer. The abstract added to the specification is supported by the original specification, and also is contained in the published application WO0032542. Applicants amend claim 15 for clarity by adding the phrase "individual carriers comprise all the attributes that define a corresponding code before commencing synthesis of a respective compound thereon, and wherein the population of detectably distinct carriers constitutes at least about 70% of the plurality of carriers." The amendment is supported by the original specification, see for example, Example 2, and page 30, line 30. No new matter has been added. Withdrawal of the rejections and allowance of the claims are solicited.

Objection to Specification:

The Examiner has objected to the specification due to the abstract. Applicants herewith submit an abstract of the disclosure, which is supported by the original specification, and is in accordance with the published application WO 0032542.

Anticipation Rejections:

On pages 3-8 of the office action, the Examiner maintains the rejection of claims 15-25, 27, and 29 under 35 U.S.C. § 102(b) allegedly as being anticipated by U.S. Patent No. 5,708,153 (Dower *et al.*).

Specifically, the Examiner asserts that the intended use claim language does not distinguish the claimed invention in structural terms over Dower. That is, according to the Examiner the carriers are being used as solid-supports/codes for organic synthesis reactions where the tags can be identified "before, during and after" said synthesis. In other words, according to the Examiner, the claims require additional structural features to adequately distinguish over the carriers disclosed by Dower. In support of the allegation, the Examiner construes the phrase "before ... said synthesis" as before the completion of the synthesis of a compound on a respective carrier. Applicants respectfully disagree with the Examiner's view of Dower and refer as follows:

In order to reject a claim under 35 USC § 102, the examiner must demonstrate that each and every claim limitation is contained in a single prior art reference. See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986); see also MPEP § 2131. Claim limitations are to be given their plain meaning as understood by the person of ordinary skill in the art, particularly given the limitations of the English language. See MPEP §§ 707.07(g); 2111.01. Claims are to be given their broadest reasonable interpretation consistent with applicants' specification. See *In re Zletz*, 13 USPQ2d 1320, 1322 (Fed Cir. 1989) (holding that claims must be interpreted as broadly as their terms reasonably allow); MPEP § 2111.

Without acquiescing to the propriety of the rejection of the claims 15-25, 27, and 29, applicants amend claims 15 for clarity by adding the phrase "individual carriers comprise all the attributes that define a corresponding code before commencing synthesis of a respective compound thereon, and wherein the population of detectably distinct carriers constitutes at least about 70% of the plurality of carriers." Applicants further clarify that the carriers comprise all the attributes that define a relevant code before the commencement of any compound synthesis. Amended claim 15 now recites that the population of detectably distinct carriers constitutes at least about 70% of the plurality of carriers.

Comparing the currently amended claim 15 with figure 2 of Dower, applicants indicate, it is clear that none of the carriers that are present at the commencement of Dower synthesis comprises all the attributes that define a code, which distinctively identifies a respective carrier from other carriers before commencing compound synthesis. In addition, applicants point out that Dower does not teach or suggest a population of detectably distinct carriers that constitutes at least 70% of the plurality of carriers. Therefore, Dower does not anticipate the instant claims. Withdrawal of the rejections is requested.

On pages 8 to 11 of the office action, the Examiner also maintains the rejection of claims 15 to 29 under 35 U.S.C. § 102(b) allegedly as being anticipated by U.S. Patent No. 5,674,698 (*Zarling et al.*). On page 10 of the office action, the Examiner

asserts that "the features upon which the applicant relies (e.g., "pre-encoded," "combinatorial synthesis") are not recited in the rejected claims." The Examiner also states that "applicants state that Zarling's disclosure of phosphors does not distinctly identify the respective carriers, but [they] do not specifically point out any rationale or evidence". Applicants respectfully disagree with the Examiner's allegations and note that the Examiner has failed to consider applicants earlier submissions that Zarling does not teach or suggest a plurality of carriers, including a population of detectably distinct carriers. Applicants also point out that there is no mention or suggestion in Zarling of a detectably diverse population of carriers in which a respective carrier comprises all the attributes, which define a code that distinctively identifies the carrier from other carriers before commencement of compound synthesis. Moreover, in Zarling *et al.* there is no teaching or suggestion of such a population that constitutes at least 70% of a plurality of carriers. Therefore, Zarling *et al.* do not anticipate the instant invention. Applicants therefore request to reconsider and withdraw the rejections.

On pages 11 to 15 of the office action, the Examiner also maintains the rejection of claims 15 to 25, 27 and 29 under 35 U.S.C. 102(b) and alleged as being anticipated by U.S. Patent No. 5,751,629 (Nova *et al.*). Specifically on page 12 of the office action, the Examiner refers to Figure 1 of Nova and alleges that before the "A-C-E" oligomer is synthesized in this figure, the beads encoding the dimmers (e.g., A-C, B-C, A-D, B-D) are each labeled with two detectable tags and/or indicia (e.g., a-c, b-c, a-d, b-d) that distinctively identifies each of the carriers. Based on the above, the Examiner asserts that "before" the [completion of the] synthesis of the A-C-E oligomer, each of the carriers are distinctively identified by a code that is derived from at least two detectable and/or quantifiable attributes (e.g., a-c, b-c, a-d, b-d), as required by claim 15. Apparently, the Examiner has interpreted the phrase "before ... said synthesis" in a similar fashion to the rejection based on Dower. Again, applicants respectfully disagree with the Examiner and refer to compare the currently amended claim 15 with figure 1 of Nova. Applicants indicate, it is clear that none of the carriers that are present at the commencement of Nova synthesis comprises all the attributes that define a code, which distinctively identifies a respective carrier from other carriers before commencing compound synthesis. In addition, applicants point out that Nova does not teach or

suggest a population of detectably distinct carriers that constitutes at least 70% of the plurality of carriers. Therefore, Nova does not anticipate the instant claims.

On page 12 of the office action, the Examiner also indicated that "claims do not state that all of the attributes have to be present before the synthesis of the compound....." In response, the applicants refer to the currently amended claim 15 and point out that the claim recites that "individual carriers comprise all the attributes that define a corresponding code before commencing synthesis of a respective compound." Withdrawal of the rejections is therefore solicited.

CONCLUSION

In view of the above amendments and arguments, applicants respectfully request the withdrawal of all rejections of the pending claims and that the case be passed to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'J. P. Isacson', written over a horizontal line.

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